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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,821	01/25/2002	Takayoshi Togino	P 284148 OL85300N-US-DIV	4939

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EXAMINER

SHAHER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,821

Applicant(s)

TU GINO

Examiner

R.D. SHAFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 1/25/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 6-12 AND 14-25 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 6-12 AND 14-25 are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 6-12 and 14-18, drawn to an image-forming system comprising a first prism member having a first entrance surface, a first reflecting surface, a second reflecting surface and a first prism exit surface and a second prism member having a second prism entrance surface, a third reflecting surface, a fourth reflecting surface and a first exit surface with particular prism members details (Bsp), classified in class 359, subclass 834.
  - II. Claims 19 and 20, drawn to a camera having an image-forming system comprising a first prism member having a first entrance surface, a first reflecting surface, a second reflecting surface and a first prism exit surface, a second prism member having a second prism entrance surface, a third reflecting surface, a fourth reflecting surface and a first exit surface, an image-erecting optical system and an ocular optical system (ABbr), classified in class 396, subclass 79.
  - III. Claims 21 and 23, drawn to an electronic camera having an image-forming system comprising a first prism member having a first entrance surface, a first reflecting surface, a second reflecting surface and a first prism exit surface, a second prism member having a second prism entrance surface, a third reflecting surface, a fourth reflecting surface and a first exit surface, an image pickup device, a recording medium and an image display device (CBbr), classified in class 396, subclass 172.

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- IV. Claim 22, drawn to a camera having an image-forming system comprising a first prism member having a first entrance surface, a first reflecting surface, a second reflecting surface and a first prism exit surface, a second prism member having a second prism entrance surface, a third reflecting surface, a fourth reflecting surface and a first exit surface, an objective optical system and a finder optical system (DBbr), classified in class 396, subclass 84.
- V. Claim 24, drawn to an endoscope system comprising an observation system having an image-forming system comprising a first prism member having a first entrance surface, a first reflecting surface, a second reflecting surface and a first prism exit surface, a second prism member having a second prism entrance surface, a third reflecting surface, a fourth reflecting surface and a first exit surface, and an illumination system (EBbr), classified in class 600, subclass 160.

2. Claim 25 link(s) inventions I-V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 25. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such ~~claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are~~ presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting

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rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because:

Inventions II-V and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular prism members details as evidenced claims 19, 21, 22 and/or 24. The subcombination has separate utility such as an image-forming optical system without an image-erecting optical system, an ocular system, an image pickup device, a recording medium, an image display device, an objective system, a finder system or illumination system.

Inventions II-V are related as subcombinations disclosed as usable together in a single combination or are patentably distinct each from the other as noted by their separate details. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions II-V have separate utility such as an optical apparatus with the separate details of the other invention(s). For example, the optical apparatus of group II has a separate utility as an optical apparatus without the image pickup device, recording medium or image display device of group III, the objective system or finder system of group IV, or the

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illumination system of group V, and the optical apparatus of group III has a separate utility as an optical apparatus without the image-erecting optical system or ocular system of group II, the objective system or finder system of group IV, or the illumination system of group V, and ...etc. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A). The species depicted by Fig. 5;
- B). The species depicted by Fig. 6;
- C). The species depicted by Fig. 7; and
- D). The species depicted by Fig. 8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 25 is generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

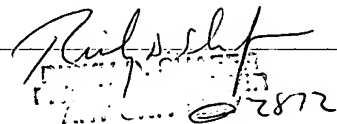
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (703) 308-4813.

RDS

December 27, 2002

Handwritten signature of R.D. Shafer, with the number 2872 written below it.